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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,276	10/07/2003	Elmer V. Pass	PASS	3830
7590	11/20/2006			
Elmer V. Pass 822 Monaco Dr. Ponta Gorda, FL 33950			EXAMINER NGUYEN, KHOI	
			ART UNIT 2196	PAPER NUMBER

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/679,276

Applicant(s)

PASS, ELMER V.

Examiner

Khoi Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/07/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Priority

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C.

119(e). Copendency between the current application and the prior application is required. Since the applications are not copending, the benefit claim to the prior-filed provisional application is improper. Applicant is required to delete the reference to the prior-filed application from the first sentence(s) of the specification, or the application data sheet, depending on where the reference was originally submitted, unless applicant can establish copendency between the applications. For the purpose of examination, the effective filing date for this application will be of 10/07/2003.

Claim Objections

1. The following claims are objected to for lack of antecedent basis:
 - a. "the program", claim 1, lines 4, 6, 8.
 - b. "the data", claim 2, line 10 and claim 3, line 14.
 - c. "said data", claim 3, line 11.
 - d. "stored data", claim 3, line 16.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 2-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

I. The following phrases are not clearly understood, rendering the corresponding claims vague and indefinite:

- a. "the first 64 bits of data" of claim 2, lines 4 and 11 and claim 3, lines 6 and 15. It is not clearly understood what data it is referring to and whether it is referring to the first 64 bits of data of the TCP/IP header, email message header or attachments of the email message.
- b. "the first 64 bits" of claim 2, line 5 and claim 3, line 7. It is not clearly understood whether it is referring to the first 64 bits of the data in the email message header, attachments of the email message, or of any part of a TCP/IP packet.
- c. "a header" of claim 2, line 4 and claim 3, line 6. It is not clearly understood whether it is referring to the email message header or the TCP/IP packet header or any other packet header.

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d. "the data" of claim 2, line 10 and claim 3, line 14. It is not clearly understood what data it is referring to or whether it is referring to the data of the first 64 bits or the data in the attachments of email message.

e. "stored data" of claim 2, line 11 and claim 3, line 16. It is not clearly understood whether it is referring to data in a reserved place or any data stored in any part of the TCP/IP packet.

II. Claim 1 is rejected as it fails to define the invention in a manner required by 35 U.S.C 112, second paragraph. The claim is narrative in form and replete with indefinite and functional or operational language. The steps, which go to make up the method, must be clearly and positively specified. None of the cited steps clearly and positively specify steps for stopping Internet virus from spreading via email.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(e) that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claim 1 is rejected under 35 U.S.C 102(e) as being anticipated by Marshall et al. (US Patent No. 7,017,187), hereafter "Marshall".

6. With regard to claim 1, Marshall discloses a method for stopping internet viruses from spreading via Email and damaging computer memory systems (abstract), said method comprising the steps of:

Inserting a first routine in the program, which receives Email attachments (Col. 2, lines 41-43; Col. 3, lines 29-30, lines 63-66)

Inserting a second routine in the program that opens attachments (Col. 3, lines 63-66), and

Inserting a third routine in the program, which forwards Email (Col. 2, lines 41-43).

Allowable Subject Matter

7. Claim 2 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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8. Claim 3 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

9. The following is a statement of reasons for the indication of allowable subject matter:

With regard to claim 2 and 3, prior art of record fails to show or reasonably suggest, the steps of "moving first 64 bits of data to a reserved place in the header and placing a binary zero into the first 64 bits, asking user if they would like to replace the first 64 bits of data in the attachment, and checking if the data has been replaced, otherwise, replacing the first 64 bits of data with stored data".

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. US. Pat. No. 6357008 to Nachenberg (Detecting new virus, examining it in a simulation environment and recorded in the data to be used by AV software)

b. US. Pat. No. 5774077 to Schouhamer Innink (Discloses bit shifting bits into n-bit channels and ensures the encoding scheme injects proper "zero" in the sequence).

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c. US. Pat. No. 6205432 to Gabbard et al. (Injecting advertisement into email messages to be displayed in the background of the message).

d. US. Pat. No 6910134 to Maher, III et al. (Discloses examining the entire header and zero out the data packet of an attachment)

e. US. Pub. 2004/0073617 to Milliken et al. (Detecting transmission of unwanted e-mail messages, compares hash value with prior e-mail message, and reject the message).

f. US. Pub. 2003/0217286 to Carmona et al. (Detects and delete/modify first section of malicious application code, and if it is, scan the rest of the code for possible remainder of the malicious code).

g. US. Pub. 2004/0015554 to Wilson (Detects junk e-mail via plug-in and performs system challenge to make sure that the original destination is known to recipients).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoi Nguyen whose telephone number is 570-270-1251. The examiner can normally be reached on M-Fri (7:30-5:00) Fri (7:30 - 4:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nabil E. El Hady can be reached on 571-272-3963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KN
Khoi Nguyen


NABIL M. EL-HADY
SUPERVISORY PATENT EXAMINER